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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,040	04/27/2001	James C. Hillegass	2161	1500

7590 06/28/2005

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EXAMINER

DINH, MINH

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,040

Applicant(s)

HILLEGASS ET AL.

Examiner

Minh Dinh

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 9-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 9-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment filed 04/01/2005. Claims 1, 3-7 and 10-17 have been amended; claims 2 and 8 have been cancelled; claims 18-20 have been added. The specification has also been amended. Since paragraph numbers are not provided in the specification, applicant is requested to use page and line numbers when referring to the specification.

Response to Arguments

2. Applicant's arguments with respect to claims 1 and 4 and 6-20 have been considered but are not persuasive. Applicant's amendments have necessitated a new search and new grounds of rejection.

3. Applicant's arguments with respect to claims 6-20 have been considered but are not persuasive. The new limitation, a user license having a user ID and a computer system ID, has been added to independent claims 6, 10, 12 and 15-19, which claims methods and system for distributing, purchasing, using and verifying a digital token. However, the specification does not disclose using a user license having a user ID and a computer system ID in distributing, purchasing, using and verifying a digital token.

Specification

4. The disclosure is objected to because of the following informalities: the serial number of the copending application provided in the amendment does not correspond to the title in the specification (page 11, lines 13-14).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 6-7 and 9-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claims 6, 10, 12 and 15-19, which claims methods and system for distributing, purchasing, using and verifying a digital token requiring a user license having a user ID and a computer system ID. However, the specification does not disclose any embodiments that support the claimed invention. The specification discloses checking the user license only when playing a licensed product (page 26, lines 1-8). The specification also discloses buying a product license using digital tokens (page 23, lines 16-23) and that a user license is not created until a

Art Unit: 2132

product license is successfully purchased (page 26, lines 16-21). Claims that are not specifically addressed are rejected by virtue of their dependency

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Glassman et al (6,523,012).

Regarding claims 1 and 3, Glassman discloses a digital token stored on a user's computer, the digital token comprising a token identifier, a user identifier, a vendor identifier identifying the vendor that sold the token and a monetary value of the token (figures 3B, 4 and 6).

Regarding claim 4, Glassman discloses a method comprising: receiving a data transmission comprising a credit card number, a monetary amount and a unique previously-assigned identifier (fig. 3; col. 5, lines 45-47; col. 6, lines 9-15); assigning a unique token identifier and storing said token identifier in association with said user identifier and said amount (fig. 4; col. 5, lines 45-47; 65-68; col. 6, lines 19-21); and

Art Unit: 2132

transmitting to the user who is associated with said identifier a digital token including the token identifier, the user identifier and a token-vendor identifier identifying the vendor that sold the token (figures 3B and 4).

Regarding claim 5, Glassman further discloses storing a customer secret which meets the limitation of a password (col. 6, line 47 – col. 7, line 5; col. 7, line 46 – col. 8, line 5).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,802,497 to Manasse

U.S. Patent No. 6,424,953 to Glassman et al.

U.S. Patent No. 6,453,305 to Glassman et al.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

Art Unit: 2132

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number is 571-272-3802. The examiner can normally be reached on Mon-Fri: 10:00am-6:30pm.

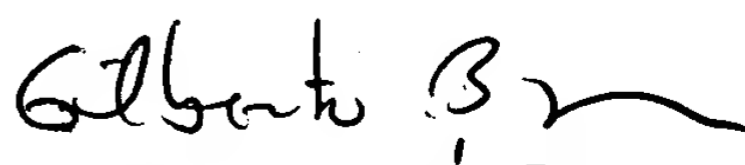
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MD

Minh Dinh
Examiner
Art Unit 2132

MD
6/22/05


GILBERTO BARRON JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100